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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/526,037 03/15/00 FRANKLIN

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EXAMINER

QM12/0709

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ART UNIT

PAPER NUMBER

3724

DATE MAILED:

07/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/526,037

Applicant(s)
Franklin et al.

Examiner
Clark F. Dexter

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3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9 and 14-22, drawn to a cutting process with cut product handling, classified in class 83, subclass 23.
 - II. Claims 1, 8-16 and 23-26, drawn to a cutting process with specific length measuring steps, classified in class 83, subclass 13.
 - III. Claims 27-31, 38 and 39, drawn to a cutting apparatus with a specific web handling/tensioning structure, classified in class 83, subclass 175.
 - IV. Claims 27, 32 and 33, drawn to a cutting apparatus with a transfer device, classified in class 83, subclass 78.
 - V. Claims 27 and 34-37, drawn to a cutting apparatus with a specific length measuring detection system, classified in class 83, subclass 284.
2. Claims 1-14 have been restricted such that the patentability of the invention is presumed to lie in the details of the particular group (e.g. the cut product handling of Group I). It is noted that if claim 1 as originally filed is part of an elected group and determined to be patentable, rejoinder of claims 1-14 will be considered. The same applies to each of claims 15 and 27 with respect to the claims dependent therefrom. It is further noted that claim 1 is listed as part of both of groups I and II but is not considered to be part of either of these groups. Rather, claim 1 recites subject

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matter that is common to both groups and has been shown as part of each group for clarity (i.e., so that it is clear which claims are part of which group). Further, because claim 1 includes subject matter which is common to both groups, it is not considered to be independent or distinct from either of the groups. Therefore, claim 1 will be examined with upon election of either group I or group II. Similarly, independent claim 15 is common to groups I and II and will be examined upon election of one of these groups; and independent claim 27 is common to groups III-V and will be examined upon election of one of these groups. It is further noted that claims 8, 9, 14 and 16 are considered to set forth subject matter which is not distinct from either of groups I and II and thus will be examined upon election of one of these groups.

3. The inventions are distinct, each from the other because of the following reasons:

Process vs Apparatus

4. Inventions I and II are related to inventions III-V as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another materially different apparatus.

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Process Groups I-II

5. Inventions of groups I and II are separate inventions. They are distinct because the invention of group I does not require the specific details of the length measuring steps of group II for patentability as evidenced by the omission thereof from group I, and the invention of group II does not require the cut product handling steps of group I for patentability as evidenced by the omission thereof from group II.

Apparatus Groups III-V

6. Inventions of groups III and IV are separate inventions. They are distinct because the invention of group III does not require the transfer device of group IV for patentability as evidenced by the omission thereof from group III, and the invention of group IV does not require the specific details of the web handling/tensioning structure of group III for patentability as evidenced by the omission thereof from group IV.

7. Inventions of groups III and V are separate inventions. They are distinct because the invention of group III does not require the specific length measuring detection system of group V for patentability as evidenced by the omission thereof from group III, and the invention of group V does not require the specific details of the web handling/tensioning structure of group III for patentability as evidenced by the omission thereof from group V.

8. Inventions of groups IV and V are separate inventions. They are distinct because the invention of group IV does not require the specific length measuring detection system of group V

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for patentability as evidenced by the omission thereof from group IV, and the invention of group V does not require the transfer device of group IV for patentability as evidenced by the omission thereof from group V.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Species

10. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Species A - measuring length prior to placement on a web/conveyor;
- Species B - measuring length prior to placement on a web/conveyor;
- Species C - measuring tension prior to web encountering feed roll;
- Species D - measuring tension prior to web encountering feed roll.

Upon election of one of the groups listed below, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is a generic process claim; and claim 27 is a generic apparatus claim.

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Upon election of Group I, applicant must elect one of species A and B, and further elect one of species C and D;

Upon election of Group II, applicant must elect one of species C and D; and

Upon election of Group III, applicant must elect one of species C and D;

No species election is necessary upon election of either of Groups IV or V.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
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cf
July 3, 2001